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IN THE

Supreme Court

of the

United States

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No. 273 October Term, 1922

GEORGE E. VANDENBURGH,
Petitioner-Complainant,

vs.

TRUSCON STEEL COMPANY,
a Corporation,
Respondant-Defendant.

Brief of Petitioner

On writ of certiorari to the United States Circuit Court of Appeals in and for the Sixth Circuit and the U. S. District Court for the Northern District of Ohio.

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GEORGE E. VANDENBURGH,
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TRUSCON STEEL COMPANY,
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BRIEF FOR PETITIONER.

PRELIMINARY STATEMENT.

May it please this Honorable Court:

This case comes up for hearing before this Honorable Court from a decision of the Circuit Court of Appeals for the Sixth Circuit upon a writ of certiorari granted by this Honorable Court. The case involves reissued patent No. 14,182 granted by the Patent Office August 15, 1916, original No. 841,741 dated January 22, 1907, on a concrete reinforcement consisting of a coil of wire with longitudinal spac-

ing or reinforcing bars having integral spurs for holding the coils in place.

The suit is brought by the patentee himself and is one of several such suits brought against other defendants on the same patent for precisely similar infringements.

In the case of Vandenburgh vs. Concrete Steel Company, reported at 258 Federal Rep. 143, the patent has been sustained as to claims 3 and 5 by the Circuit Court of Appeals for the Second Circuit, an application for certiorari thereon being denied by this Hon. Court. Thereafter it was reported by the Master that something over Sixteen Thousand ($16,000) Dollars is due the plaintiff. The report of the Master was confirmed by the District Court and by the Circuit Court of Appeals for the Second Circuit, from which decision another writ of certiorari was asked which was granted by this Honorable Court and which case it is assumed will be heard just prior to this one. The last decision will be found at 278 Fed. R. 607.

In the case of Vandenburgh vs. Electric Welding Company, 263 Fed. 95, the Circuit Court of Appeals at Philadelphia holds claim 3 valid in the following words: **"Finding his kerfed combination novel, regarding it as useful, and assuming for present purposes, as we will, that it embodied invention, there is no reason for regarding it as other than a narrow contribution to the art of a specific type of coil and bar attachment."**

The Circuit Court for the Sixth Circuit has the following to say concerning the validity of claim 3: "It is true that this particular method of attaching the loop to the upright was new as applied to the art of metal reinforced concrete. . . . We recognize that the use of diagonal kerf and overhanging spur method of connection in a non-analogous art did not anticipate the combination claim in question (3). . . Our conclusion is that, assuming for the purposes of this opinion that the claim in question involves some measure of invention, it is so narrow as to be practically limited to the specific method of fastening disclosed, and that it cannot be extended to cover defendant's method." This makes extended notice of the alleged anticipations in this case unnecessary, the references having been exhaustively reviewed in every court previously.

THE ERRORS ASSIGNED.

The errors assigned in the decision in the court below are as follows:

(1) In adopting "without further statement of . . . reasons" previous decisions as to the invalidity of claim 1.

(2) In not adopting the decisions of the Courts of Appeal of the Second and Third Circuits as to the validity of claim 3.

(3) In holding that the "kerfs of plaintiff's patent are required to be cut at an inclined angle to the edge of the bar."

(4) In holding that the kerf and spur . . . were intended to and do hold the spiral rigidly or permanently in place.

(5) In holding that defendant's spiral is not held rigidly or permanently in place.

(6) In holding claim 1 void.

(7) In holding claim 3 "void for want of patentable novelty."

(8) In holding uncontradicted testimony of two witnesses insufficient to establish the date of plaintiff's original invention.

(9) In holding that combination claims are void because their several elements are old in other arts and locations.

(10) In holding that patents from the metal working arts are pertinent to concrete reinforcing.

(11) In holding that any patent in the record negatives the patentable novelty of either claims 1 or 3 and especially that Kieserling, Moller and Christophe do not do so.

(12) In holding that "Considere, Christophe or Marquess as well as numerous inventors" disclosed or showed anything which anticipates claims 1 or 3.

(13) In holding that plaintiff's claim 3 "comes in conflict literally with the existing prior art."

(14) In holding that "no new function is accomplished or performed as a result . . . of the new combination" of claim 3.

(15) In holding that "no new function of elements or new method of operation is involved, and the result achieved exactly the same as in the old one."

(16) In holding that plaintiff's inability to commercially work his invention more than he has is in any way a bar to recovery on his patent.

(17) In holding that the only invention of plaintiff is "the exact construction described and pictured in Figs. 1 and 6."

(18) In not holding claims 1 and 3 valid and infringed.

(19) In dismissing the complaint at the cost of plaintiff.

Owing to the fact that the certiorari writ had been granted in the case of Vandenburgh vs. Concrete Steel Company, and owing to the fact that the patent will expire January 22nd, 1924, a petition for rehearing was not presented to the Circuit Court of Appeals for the Sixth Circuit, although it was prepared, and one matter that was to be presented in it is asked to be considered here, that is, that the

printed publications offered in evidence were insufficiently proven and should be excluded.

THE ISSUE.

The invention as stated above consists of a coil of wire secured to a longitudinal bar by means of prongs integral with the bars. It may be used for all kinds of concrete reinforcing, but the defendant sells its reinforcing for use in columns.

The art shows the invention to be a pioneer patent in its limited field, a cloud of patents on the same subject matter following closely after Vandenburgh.

The claims in issue herein are as follows:

> 1. A concrete reinforcing consisting of a bar having a plurality of integral spurs, and a spiral coil permanently secured thereto by having the spurs bent down on the several coils, the coils extending beyond and free of the bar at the opposite side therefrom to the securing point.
>
> 3. A reinforcing bar provided upon one edge with a series of kerfs each having an integral over-lapping spur, and a coil disposed in said kerfs, each convolution thereof being retained beneath one of said spurs.

The original claims these replaced are as follows:

> 1. In a reinforcing-bar, a spiral coil rigidly secured thereto at two points in each convolution thereof and extended beyond and free of said bar at the opposite side therefrom to the securing point.
>
> 3. A reinforcing bar provided upon one end with a series of kerfs each having an integral overlapping spur, and a coil disposed in said

kerfs, each convolution thereof being retained beneath one of said spurs.

The language of the claims is clear beyond the average patent claim, but since much has been made of a supposed difference between the patent and defendant's construction, the following excerpts from the reissue will be made:

> "The invention has for an object to provide a reinforcing bar with one or more spirally disposed coils secured to the bar so as to provide an extended area of contact adapted to resist strain longitudinally and laterally of the bar and to form a truss within the body of concrete or the plastic material which provides the maximum of supporting strength in the arch or surface to be formed."
>
> "In Fig. 6 a modified application of the invention is shown where two of the bars are disposed parallel to each other, with their coils intermeshing, for use in column or girder construction, wherein such a construction provides the maximum of strength in the reinforcing material."

Near the end of the specification the following paragraph is found:

> "It will be seen that this form of bar is very simple and economical in construction while embodying the greatest efficiency in use. This bar, although described in connection with arch and column construction, is adapted for use in any character of metal, reinforced concrete, or cement construction."

The foregoing excerpts show, beyond cavil, that the structure was intended for use in any kind of

concrete structures, without regard to the relative size of the bars used, and that it was particularly applicable to columns is an undisputed fact.

The extracts are word for word the same as are found in the original patent. In fact the drawings of reissue and original are duplicates and the specifications are verbatim the same. See the record for the patent copies, pages 208 and 212.

Much time was spent in the court below in considering whether plaintiff's reinforcing was suitable for beams alone or for columns, but this question has been conclusively settled by the decision of the court below.

However, in addition to the above, even if applicant did not describe the use of the reinforcing in connection with columns, the law is that he is entitled to protection in any field in which it may be applied. Zinn vs. Weiss, 7 Fed. Rep. 916; Union Co. vs. Allen, 14 F. R. 353; Cincinnati Co. vs. Brewing Co., 31 F. R. 472; Potts vs. Creager, 155 U. S. 606; and many others of like import. Justice Brown said in the latter case: "A patentee is entitled to every use of which his invention is susceptible, whether such use be known or unknown to him."

DEFENDANT'S CONCRETE REINFORCING.

Defendant makes and sells a column reinforcing which consists of a coil to which are connected two longitudinally extending bars by means of slots with prongs pressed over the coil elements from both

sides of the slots. See the cuts of defendant's structure, pages 211, 215 and 217 of the record, the latter photograph clearly showing the overlapping prongs in eight different places. The structure is identical with that of the patent save that the slot used is at right angles to the bar while the patent shows diagonal slots. The additional bar in no way changes the invention, nor does it in any way avoid the charge of infringement for the same two bars were used by the Concrete Steel Company and the U. S. Court of Appeals at New York holds that structure to be an infringement of claims 3 and 5 of the patent, both of which are held valid.

The claims (1 and 3) in issue herein are so clear there can be no doubt on the subject of infringement for the defendant's coils are placed in a "slit," "cut," "notch," or "groove" made by "sawing or cutting" in one edge of the bar supporting them, all of which are given as synonymous with kerf in the dictionaries. The coils are also held in place in the notches by pounding down on the corners of the metal adjacent the slots to produce spurs which must be sufficiently bent over the coil elements to hold them in place. If they were not bent over the coil elements, the latter would not be held in place. The spurs can be seen in the photographs. Also see the uncontradicted testimony of Mr. Thayer, record page 115, and that of Mr. Vandenburgh, page 28. The coils, in both instances, are held permanently

in place just exactly as is recited in the body of the original patent, and the fact that defendant uses a small bar in no way changes its character as reinforcing. Neither claim in issue is limited to the diagonal position of the kerf.

THE INVENTION.

At the time of plaintiff's invention, about 1903, see pages 25, 96 and 100 of the record, the concrete art was well developed and the commercial exploitation of the art was beginning, which in a few years (1907) was to be carried on on an enormous scale. Like the majority of patentees, the plaintiff did not immediately file his patent application but did so on May 9, 1906. He was seeking and found a way to improve concrete reinforcing which makes use of spiral coils in conjunction with longitudinal bars to which the coils are secured by prongs integral with the bars. It appears from the record, see pages 73, 116, 118, that such a construction has a number of advantages over the structures which existed prior to plaintiff's invention, see the testimony of defendant's witness, Turneaure, as well as that of Prof. Thayer.

Coils and sundry kinds of fastenings had been used previously but following plaintiff's invention practically all column reinforcing of this type has followed the steps of the plaintiff. Many thousand tons of it have been used and with its striking ad-

vantages over previous forms it is being more largely used all the time, practically only one manufacturer making a spiral of a different character. In fact, it is no secret that the construction is far more valuable than plaintiff ever had any idea of at the time he made the invention.

DECISIONS RELIED ON BY THE COURT BELOW:

The court below upon the question of invention relies upon the cases of Trussed Concrete Steel Company vs. Goldberg, 222 Fed. 506; Day vs. Mt. City Milk Company, 264 Fed. 963, and Berger Company vs. Trussed Concrete Co., 257 Fed. 741.

The Goldberg case is not pertinent to any issue herein. The specification of that patent simply displays the fact that truss reinforced concrete was old, and the fact that this reinforcing is used for truss and column purposes in no way affects the present matter, because with the present case we are concerned wholly with very specific claims on details of a different character brought into a highly developed art by this inventor.

The Day case had to do with the case of a biscuit cutter having the same structure as a brick cutter. In other words, the one machine handled a dough made from flour, whereas the second machine handled a dough made from mud. Obviously the two things were so close in actuality as to make it

probable that one person seeing the biscuit dough machine working would think that it would work equally well with a machine for cutting a dough made from mud. Even that statement is negatived by the Potts vs. Creager case, cited elsewhere.

In the Berger case a metal lathing was attached with prongs to metal studding, in which exactly the same function was then performed as had been previously performed in connection with the art, and the product was a fixed immovable structure no different from the prior art when its parts were assembled.

In the present case the structure is completed prior to being set up and has certain novel mechanical properties independent of the structure in which it is finally assembled, so this case is entirely different from the ones above cited. Here a movable structure having new mechanical functions is produced of old materials and elements. This patent discloses for the first time a spiral concrete reinforcing capable of being self-sustaining, as a complete shop assembled manufactured article and capable of being collapsed for shipment, and for the first time discloses a spiral adequately and properly fastened to the longitudinals at each of the several joints, and in a way that does not weaken the spiral, as well as in a way that makes the fastenings permanent and secure when the concrete is being poured and when in use. For example, Prof. Thayer says:

"To rivet the spirals to the longitudinal would so weaken them as to make it impractical." See page 199 of the record. Prof. Thayer also says: "That the clip fastenings are not as good as the integral prong fastener as they are liable to be displaced." See page 198 of the record. Prof. Thayer also says "That the spiral reinforcing with securing prongs integral with the longitudinals have two very great advantages, the collapsibility of the column for shipping, and the fact that it holds it in its proper position as the concrete is being placed." And he also says "That these spirals have more or less supplanted other forms." See pages 116 and 118 of the record. He also states that "there are not less than five other patents on substantially the same subject matter following the Vandenburgh filing date." See page 117, and these patents are shown in the record from pages 287 to 310.

Prof. Turneaure, defendant's own witness, an expert widely known, says of the spiral reinforcing with the longitudinals having integral prongs for securing the spirals in position "that most of the spirals used today are made that way and supposes it is more economic and convenient to make them that way." He says "They are easily set up in the shop, easily handled, easily shipped and it is easier to get them in a uniform position." He says: "There are some advantages I can think of. I am not a practical builder, so I probably haven't thought of

all of them. There are advantages. There might be over some other construction. I do not have any in mind now, but it is very evidently a good arrangement." Record page 73. None of this testimony is denied.

LAW POINTS INVOLVED.

This case baldly comes before this court upon the following propositions of law:

1. Is the reissue statute to be so narrowly construed as to prevent mistakes unknown to a brick mason, unlettered in the law, from being corrected when those mistakes are brought to his attention by somebody who knew something about the subject and when such corrections narrow the scope of the claims in which they were made?

2. Is a device unpatentable because of its simplicity where it is admitted that the construction substantially displaced all others but one, and where it is far more economical to produce and far better in results than all those preceding it, and where immediately after it came out it was followed by a number of other patents on detail constructions of the same thing?

3. Whether infringement can be avoided by making something slightly different from the thing shown in the drawings of the patent, i. e. a cut at right angles instead of on a diagonal, when the claim

is not particularly limited to that particular form, where the combination is new and where new and useful results are attained as a result of the use of the combination, and where the parts are identical in name, function and number?

4. Whether the uncontradicted testimony of two credible witnesses as to the date of plaintiff's original invention can be utterly disregarded?

5. Whether merely offering, without proof, printed matter bearing a given date is sufficient to anticipate a duly proved patent?

6. Whether printed publications less than two years prior to applicant's filing date are valid references against him?

7. Is a simple invention for that reason unpatentable?

8. Many other points have been urged in different briefs but all seem to be abandoned save the ones here urged, so those have not been touched herein.

THE LAW OF THE CASE.

This court requires no information upon the law points presented, but in order that it may have at hand in this brief the pertinent authorities, they are assembled herein under their proper headings.

LAW POINT NO. 1.

THE REISSUE.

Obviously the reissue statute was enacted for the correction of mistakes in patents. The statute has no other possible excuse for being. Plaintiff states, page 26 of the record, "that upon the suggestion of present counsel on July 1, 1916, he made application to have the patent reissued because there were several mistakes in the wording of some of the claims and one claim was too broad." The change consisted in the addition to claim 1, which did not describe particular and definite fastening means whereby the spirals were secured to the bars of particular and definite words showing that the spirals were secured to the bar by having integral spurs bent down on the several coils. Otherwise the claim is substantially identical save in the omission of the word "rigid" which was on an impossible function in the original. Claim 3 of the original patent recited that the kerfs were upon one "end" of the bar, whereas the correction was obviously to have the claim to read that the kerfs were upon one "edge" of the bar.

This Honorable Court in the case of Abercombie vs. Baldwin, 254 U. S. 198, considered patent 821,580 granted May 22, 1906, and reissued on an application filed September 5, 1913, under No. 13,452. In this case the specification was amended to show that the

water supply tube extended into the chamber of carbide used in the lamp, and an entire new paragraph concerning the operation of the lamp was inserted in the specification. In the 4th claim there was a change made to indicate that the **stirring rod was of a size to restrict** and **control the flow of water** to the carbide. **None of this matter was in the original case** more than by inference, but notwithstanding that the patent was held valid and infringed in an illuminating opinion upon reissue.

In the present case the specification was not changed at all, the drawing is identical in detail. One claim was changed in one word and the first claim had the definite integral spur securing means recited in the original specification added thereto in the place of generic securing means. None of these changes amount to the change of claim 4 in the Baldwin patent.

In the case of Stanley Works vs. Twisted Wire Co., 256 Fed. R. 98, the Circuit Court of Appeals for the Second Circuit held that the Howe patent No. 13,765, a reissue of patent 1,043,771 for Box-strapping did not contain new matter and was not broader notwithstanding the fact that the reissue patent added six claims to the original, and notwithstanding the fact that claim 4 in issue **omitted the raised bearings on the edges of the box strap** found in the original patent claims.

An endeavor in this case will be made to cite only

Supreme Court cases so far as possible, but the above case is too pertinent to pass by.

This Honorable Court in the case of Westinghouse vs. Brake Co., 170 U. S. 537, held that some allowance and delay might be made in the case of an unlearned man seeking to protect himself through a patent. The causes of applicant's delay in not earlier prosecuting his cases are given on page 95 of the record as due to six falls in which he was injured, a bank failure, lack of work, and objections of the bricklayers' union to the introduction of concrete reinforcing in San Francisco where he was at that time. These cases were all as late in being presented to the Patent Office as this inventor in seeking his reissue.

In the case of Eames vs. Andrews, 122 U. S. 40, the patentee added to the reissue specification an air tight connection which had not been mentioned in the original patent and that was held not to broaden the claims, because it would obviously have to be present. This was held to be permissible.

In the present case the addition consists simply and only of words of limitation contained in the original specification.

The case of Motion Picture Co. vs. Laemmle, 214 Fed. R. 788, on reissue 13,329, December 5, 1911, a reissue of 12,037, September 30, 1902, original No. 589,168 of August 31, 1897, the court holds that "Nowhere has it been held that a reissue wherein

the claims are narrowed is void for laches." In that case the narrowed matter consisted of adding the word "perforated" as to the film used in the machine and providing that feeding devices recited in the claims should have "teeth." Practically the same kind of an addition in the present case where the words "integral spurs bent down on the several coils," were added in claim 1.

Many decisions of this court hold that a reissue is for the same invention as the original patent where the reissue claims the invention shown, described or substantially indicated in the original patent. See

Klein vs. Russel, 86 U. S. 433;
Marsh vs. Seymour, 97 U. S. 348;
Morey vs. Lockwood, 75 U. S. 230;
Seymour vs. Osborne, 78 U. S. 516;
Topliff vs. Topliff, 145 U. S. 156;
Abercombie vs. Baldwin, 245 U. S. 198.

This court has also held that verbal differences in a reissue from the original do not invalidate the reissue. Gage vs. Herring, 107 U. S. 640. This disposes of claim 3, and the reissue question.

LAW POINT NO. 2.

PATENTABILITY OF CLAIMS 1 AND 3.

All three Circuit Courts of Appeal concur in admitting the patentability of claim 3; their precise words being set forth at the beginning of this brief.

and what is said of claim 3 applies equally to the broader claim 1.

Claim 1 differs from claim 3 only in the omission of the word "edge." The construction recited by claim 1 contains the same elements, to-wit: the coils, the bar, and the prongs integral with the bar bent down on the coils. It is positively and demonstrably narrower than original claim 1 and only differs slightly in scope from claim 3, so that it should be held valid as well as claim 3. It is a fact that none of the citations in this case show anything of the kind described. There are spirals fastened to the longitudinal by rivets as early as 1874. The Hyatt patent, for example, at page 340 of the record; the Kieserling patent at page 386 of the record was as early as 1894. In that case the spirals were seated in notches but no holding means of any kind was shown. Undoubtedly wires were used at that time to hold the spirals in place.

The U. S. Patent No. 302,664 to Monier of 1884 referred to in the answer at page 16, but not printed in the record, by a stipulation which permits its use, if necessary, shows a spiral wired on longitudinals.

Text books such as Buel and Hill on Reinforced Concrete describe the same kind of a structure as early as 1894, see page 295. Why did everybody wait on this patentee from 1884 to 1907 when he presented his idea? Why is it that defendant does not use these constructions, and why is it that about

eight months following the grant of plaintiff's patent all of the infringers started to making the same thing? Note the defendant's present structure was not used till December, 1910, record page 82. The patents are shown in the record pages 287 to 310.

Prof. Turneaure in the record at page 73, and Prof. Thayer in the record at pages 115, 118, 119, 198, and 203, point out the advantages of the spiral with the integral securing spurs or prongs, they say: "These are more economical, more easily assembled and set up, more easily shipped, more easily placed in a uniform position, that they are collapsible, that the prongs hold the spiral in position as the concrete is being placed, that there is no other method that makes as good a job as the integral securing means, and it would be very expensive to clip all the spirals of a large building to the longitudinals, so expensive as to be impractical." The advantages are so numerous they alone should be sufficient to sustain the patent over the art.

In the case of Diamond Co. vs. Consolidated Rubber Co., 220 U. S. 428, this court says: "It is urged that such capacity (the tipping of the tire) is not recited in the specifications of the patent, and was unknown to Grant . . ." (Here collapsibility of the spiral.)

"It was certainly not an exact repetition of the prior art. . . .

"It possesses such an amount of change from the prior art as to have received the approval of the Patent Office . . .

"Its simplicity should not blind as to its character. . . .

"Knowledge after the event is always easy, and problems once solved present no difficulties. . . .

"It is certainly not necessary that he understand or be able to state the scientific principles involved and it is immaterial whether he can stand a successful examination as to the speculative ideas involved."

"And we may say in passing that the elements of a combination may be all old. In making the combination the inventor has the whole field of mechanics to draw from."

"Decree affirmed."

In this case a long felt want in a full art was brought out and shortly after all the spiral dealers adopted it. The words of this Honorable Court apply with cogent force to this very case in every detail. They could be applied verbatim with the change of "tire" to "reinforcing" to this case.

LAW POINT NO. 3.

IS THERE INFRINGEMENT BY DEFENDANT?

This point is almost trivial, but as it is the one matter on which the court below decides against

plaintiff as to claim 3, it is necessary to treat it with the utmost seriousness.

It is obvious from the reading of claim 5 that the inventor intended to limit claim 5 to the diagonal slots shown and described in his specification. Why was that limitation omitted from claims 1 and 3, if not to make them cover obvious changes? The parts are identical in defendant's construction and in that of the patentee, the work they do is identical and the only difference lies in the cutting of the slot at right angles instead of on a diagonal as indicated in claim 5. Defendant's construction is inoperative unless it has an overhanging spur or prong to bear upon and hold the coils in place. Claim 3 does not set forth how the kerf shall be cut, and as a "kerf" is defined to be "A slit, a cut, a notch, the cut of an axe, saw, or other instrument, a channel or groove made by a saw or cutter, a notch or cut made by sawing or cutting" in a number of different standard dictionaries, it is obvious that the angle of the cut is immaterial and it will be seen at once that the infringement is clear. This court in Union Co. vs. Murphy, 97 U. S., page 125, holds:

"If two devices do the same work in substantially the same way, and accomplish substantially the same result, they are the same even though they differ in name, form or shape." This statement is absolutely on all fours with the conditions of this case. In this case there is only a form difference in

one part, and no form difference with respect to the claims in issue, and structure of the defendant.

In the case of Continental Bag Co. vs. Eastern Co., 210 U. S. 405, this court further holds:

"It is manifest, therefore, that it was not meant to decide that only pioneer patents are entitled to invoke the doctrine of equivalents but that it was decided that the range of equivalents depends upon and varies with the degree of invention."

As to the "paper patent" defense the same decision holds.

"Counsel seems to argue . . . that he (the patentee) is under a sort of moral obligation to see that the public acquires the right to the free use of the invention as soon as conveniently possible. We dissent entirely from the thought thus urged . . ." "It is his absolute property." "We cite them (prior cases) because there is something more than repetition of the same thought by doing so." "It shows that whenever this court has had occasion to speak, it has decided that an inventor receives from the patent the right to exclude others from its use for the time prescribed by the statute. And for that time the public faith is pledged."

In the case of Minerals Separation Co. vs. Butte Co., Justice Clarke, 250 U. S. 336, this court holds:

"Where the patentees came late into the field and their final step was not a long one such a patent must be construed strictly, but candidly and fairly,

to give the patentee the full benefit but not more of the disclosure of their discovery."

If there were differences in function or parts of the patented article and that made by defendant there might be some question as to infringement, but as to the claims in issue herein there is no difference.

LAW POINT NO. 4.

CAN UNCONTRADICTED TESTIMONY BE DISREGARDED?

Plaintiff at page 97 of the record fixes the date of the making of the models of his invention as at a time when he was living at 1803 Oregon Avenue, Washington, D. C., and states that all of the models were left at that place when he went to Califronia.

Benjamin Blethyn, at page 100 of the record, states that he saw the plaintiff working on the models in his shop in 1903. Mr. Blethyn describes the models he had seen and identifies them as being substantially the same as the drawings illustrating the reinforcing shown in the patent—see page 101 of the record.

In the case of Kavanagh vs. Wilson, 70 New York, 177, a leading case and followed by a host of other cases, it was said:

"It is undoubtedly the general rule that when a disinterested witness, who is in no way discredited, testifies to a fact within his own knowledge, which

is not in itself improbable, or in conflict with other evidence, the witness is to be believed and the fact taken as legally established, so that it cannot be disregarded by court or jury."

The case of Philadelphia R. R. vs. Stimpson, 14 Peters 448, it was held that the

"Testimony of the declarations of the inventor prior to the date of the original patent as to its nature and objects, are admissible as res gestae and are proof of the date and origin of his invention."

In the case of Stephens vs. Salisbury, 22 Fed. Case 1284

Verbal statements of the inventor were held to be sufficient to prove the time of invention.

And in the case of Standard Co. vs. Peters Co., 77 Fed. 646

The inventor's oral explanation antedating reduction to practice by defendant was held admissible to overcome priority over a patent.

Here there is no contradictory testimony whatsoever, but the court **simply disregarded what two witnesses** had to say upon the subject, one of them with no interest whatever in the case. It is submitted that plaintiff has sufficiently proved the date of his invention. The production of a model would not in any way confirm his sworn statements. He states when the invention was made and is corroborated by a disinterested witness. That is all

the law requires. Burden of proof does not mean a large number of witnesses.

It is also to be noted here that it is merely the date of the invention the statute refers to which is to be proved, not the time of its reduction to practice to which the statute does not refer. However, the models made were just as complete in small sizes as larger sizes of the same thing would be or could be.

LAW POINT NO. 5.

HOW IS PRINTED MATTER TO BE PROVEN?

It is obvious that printed matter offered in evidence in a case must be proven by some one. Merely offering it in evidence is no proof of its publication or existence upon the day and date that may happen to be printed upon it.

In the case of Reeves vs. Keystone Co., 1 Official Gazette 466, it was held that

"Prior publication must be proved independently of the date imprint on its page." "This date of publication must be independently proved." "As it does not appear that this book was published before the patentee's invention, as evidence it is altogether inconsequential."

In the present case, two articles from the Engineering News, one bearing a date imprint of August 4, 1904, and the other bearing a date imprint

of March 15, 1906, were offered in evidence. These papers were merely submitted to the court with no one to testify to their authenticity nor as to their time of publication. They are obviously wholly irrelevant as testimony, and one is only a couple of months prior to the filing date of the application.

LAW POINT NO. 6.

WHAT PRINTED PUBLICATIONS ARE VALID.

Reference Sec. 4886 of the Revised Statutes provides among other things:

"Any person who has invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvements thereof, not known or used by others in this country, before his invention or discovery thereof, and not patented or **described in any printed publication** in this or any foreign country, before his invention or discovery thereof, **or more than two years prior to his application** . . . may . . . obtain a patent therefor."

The two year clause has some purpose and it obviously was put in to require printed publications to be more than two years prior to the application for patent when they are to be a reference against patent claims. If the words do not mean that, they are meaningless. In fact, under well known de-

cisions, the inventor is able to carry his date of invention back more than two years for certain purposes, but cannot, when the references are printed publications carry it back, effectively, more than the given two years. In this case he has carried his date back to 1903 in the construction of his models and is entitled to the two year period antecedent to his making of the patent application.

Von Schmidt vs. Bowers, 80 Fed. 140, holds: "So far as the defense of anticipation is concerned, it must be established as of a date anterior to the patentee's invention or discovery; not merely prior to his application for, or the date of his patent: Revised Statutes 4886, 4920; Plow Co. vs. Starling, 140 U. S. 198; Clark Co. vs. Willimantic Co., 140 U. S. 481, and Loom Co. vs. Higgins, 105 U. S. 592. The fact of invention may be shown by **drawings, sketches, models or any other competent proof.**"

LAW POINT NO. 7.

SIMPLICITY OF THE INVENTION.

Mr. Justice McKenna in speaking of combination claims in Leeds vs. Victor Co., 213 U. S. 301, says:

> "A combination is a union of elements, which may be partly old and partly new or wholly old or wholly new. But whether old or new, the combination is a means an invention distinct from them."

So the age of the elements of the claims cannot be an objection to them.

In Expanded Metal Co. vs. Bradford, 214 U. S. 366, Mr. Justice Day says:

> "It is suggested that Golding's improvement while a step forward, is nevertheless only such as a mechanic skilled in the art with the previous inventions before him, would readily take; and that the invention is devoid of patentable novelty. . . . The fact that an invention seems simple after it is made does not determine the question; if this were the rule, many of the most beneficial patents would be stricken down. It may be safely said that if those skilled in the mechanical arts are working in a given field, and have failed, after repeated efforts, to discover a certain new and useful improvement, that he who makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an invention. . . . We are of the opinion that Golding's method was a substantial improvement."

In order not to burden this record with extended citations of cases it will just be mentioned that Judge Van Fleet once said: "Simplicity in mechanics is not a vice, but rather a virtue—a strength not a weakness;" and this is especially true in the field of invention. The following list of simple inventions given without their citations, but which latter can be found in the brief in the court below if wanted, shows a series of patents held valid which covered exceedingly simple inventions in each instance.

The ordinary "book match" and its enclosing "match box" were both held valid inventions. "A gas burner having inclined perforations" was held to be for a valid invention. A "spectacle case," a "celluloid cap" for pepper and salt dredges, a simple "hand mirror" and a "rubber covered button" were all held good inventions. "A flexible and detachable blade for safety razors," a "shell for protecting and covering the spokes and hub of a wheel" have been held valid inventions. As simple an article of manufacture as "a head muffler" has been held to be for a valid invention.

The "Domes of Silence" used on furniture legs, a "cushion key cap for typewriters," a "cover for cigars," a "newspaper wrapper" having a thread for opening it, and an "antifriction necktie insert" have all been held to be good inventions though simple. The list of patents could be extended to hundreds in which simple inventions have been protected.

LAW POINT NO. 8.

Long lists of authorities have not been given herein, nor have all the various points considered at different stages of this case been elaborately argued. In the first place the addition of authorities by the dozen would not change the law. In the second place the decision below has settled all but certain points and it has been the endeavor of counsel in this case to restrict this brief to only the essential details of the case.

All matters which have been really made an issue by the Court of Appeals have been treated here but all other matters have been passed over as unnecessary to answer in this brief.

CONCLUSION.

In conclusion it is quite apparent from appellee's brief in the court below that it centers its objection to the case as to claim 1 and its reissue principally upon the word "rigidly." This word has many meanings, as many words in the English language have. It is defined in the Webster's dictionary and in other dictionaries as meaning "firmly," "stiffly," "securely," which is from the Latin "rigidus," "rigeus." Any of the meanings given show that the importance placed upon the word "rigidly" by appellee vanish, if the word has its real meaning of "firmly" or "stiffly" securing the coils to the longitudinals applied thereto. Claim 1 is in a far more limited form today than it was in the original patent and should be held valid.

In the case of Towne vs. Eisner, 255 U. S. 418, this court said "A word is not a crystal . . . it is the skin of a living thought and may vary greatly in color and content." To limit the word "rigidly" to **immovable** is to depart from fact as to the possibility of the construction and to depart from fact as to the various dictionary definitions of that word, as well as to depart from the facts of the original specification which did not contain that word.

Appellee lays much stress upon his statement that the patent contained insufficient disclosure of information concerning column hooping. However, this question was completely disposed of by the court below, and decisions of this court have often been made holding that a patentee is entitled to any use to which his construction may be put. But this does not affect claim 3 in any way.

Defendant lays much stress upon this patent as a "mere paper patent." This court has effectually disposed of that question in Continental Bag Co. vs. Eastern Co., 210 U. S. 405, above cited. All patents are printed on paper. The argument is a puerile one.

This case is such a simple one that it seems a marvel that it has required more than five years to obtain that recognition for the inventor which the law provides is his as a matter of right.

The decision below should be reversed for the following reasons:

1. Having obtained a favorable decision in one Circuit Court of Appeals, a patentee should not be compelled to repeatedly litigate the same question on substantially the same testimony in other courts.

2. Claim 1 added the **"integral spurs on the longitudinals bent over the coil elements"** and removed not a single element from the original, thereby more closely limiting that claim, following

Thompson vs. Wooster, 114 U. S. 104, which holds such a change can be made at any time.

3. Claim 3 was changed verbally and not in scope, following Gage vs. Herring, 107 U. S. 640.

4. The patentee is entitled to a broad reading of his claims because he was the first in this art to make use of a type of reinforcing which has practically superseded all others in its field but one.

5. The art shows a development of spiral and longitudinal reinforcing with wire ties in the Monier patent of 1884, then for 23 years there was no commercial change when Vandenburgh's patent was published, whereupon in December, 1907, following the grant of the patent we find defendant using that method and in a short time at least five patentees and many infringers were using it.

6. Vandenburgh explains his delay in applying for the reissue because of sickness and loss of money, and promptly upon learning of the defect sought to reissue the patent.

7. Defendant does not use the things in the art it so glibly asserts are anticipations, but uses the identical structure of the patent, changing an unmentioned slope of the cut holding the coils, giving the Vandenburgh construction the tribute of its imitation as others have done. See Diamond Co. vs. Consolidated Co., 220 U. S. 428, above cited.

8. It is not in the spirit of the patent law nor in

the trend of decisions to seek by technical constructions all possible avenues to defeat a patent, but that wherever there is a doubt (here three Circuit Courts of Appeal have raised that doubt most strongly in favor of the patentee) he is entitled to protection.

"The object of the patent law is to secure to inventors a monopoly of what they have actually invented or discovered, and it ought not to be defeated by too strict and technical adherence to the letter of the statute, or by the application of artificial rules of interpretation." Topliff vs. Topliff, 145 U. S. 156. This case, it is believed, has been followed without deviation since it has been written.

It is most respectfully submitted that the decision of the court below should be reversed and the plaintiff be given the judgment he prays together with costs.

Respectfully submitted,

CARLOS P. GRIFFIN,

Attorney for G. E. Vandenburgh.

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IN THE

Supreme Court of the United States.

CONCRETE STEEL COMPANY,
Petitioner,

v.

GEORGE E. VANDENBURGH,
Plaintiff-Respondent.

October Term, 1921.
No. 674.

CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE SECOND CIRCUIT.

BRIEF ON BEHALF OF THE PLAINTIFF-RESPONDENT.

Statement of the Case.

This statement is supplemental to that of the petitioner, to which reference will now be made by paragraph and page.

The first paragraph, page 1, is correct in stating that the suit was instituted and tried before Judge Hough, etc., and it is also true that Judge Hough dismissed the bill.

The second paragraph, page 2, is incomplete. From the order dismissing the bill, the plaintiff took an appeal and was successful in part. The lower Court was affirmed as to claims 1 and 2 which were the new claims inserted in the reissue patent and was successful as to claims 3 and 5, which were original claims in the original Letters Patent, and except for a minor clerical correction in claim 3 where "edge" was substituted for "end", an obvious clerical correction, these two claims of the reissue patent are identical with the corresponding claims in the original patent which were numbered 3 and 4. As the defendant used the exact structure of claims 3 and 5 of the Letters Patent here in suit, there could be no question as to infringement, once validity was established. It may be said at the outset that this case will turn on validity and not infringement, should this petition be granted.

The same identical issue was presented to this Court in the petitioner's first petition for a writ of *certiorari* which was denied as found in the memorandum decision at 250 U. S. 664. The petition at bar is the second petition, and is the second identical request as far as this issue is concerned. There is another minor issue, as will be pointed out below, but we believe that this minor issue is of no consequence. We do not think the petitioner will be serious in the contention it makes as to the second issue.

The third paragraph, page 2, fails to state that the recovery of $15,918.33 was based on the figures submitted by the petitioner. It does not lie in its mouth to dispute these figures and they are not disputed. The petitioner sold the infringing articles and admittedly made this profit from them.

The Master, the District Court and the Circuit Court of Appeals have all found this fact and the decree has been entered accordingly.

Sub paragraph A, page 2, is somewhat misleading because the facts are not sufficiently set forth. In this Pennsylvania suit, THE ALLEGED INFRINGING DEVICE IS OF A DIFFERENT FORM FROM THAT INVOLVED HERE. Claims 1, 2 and 3 were involved. The Circuit Court of Appeals for the Third Circuit held that claims 1 and 2 were invalid, claim 3 was VALID BUT NOT INFRINGED, and it did so after a careful analysis which will be quoted below. Claim 5, which is here involved, was not before the Court, and claim 5 alone is sufficient to support the judgment in this case. The plaintiff applied to this Court for relief and its petition for a writ of *certiorari* was denied (253 U. S. 497).

As to the value of claim 3 and the structure therein covered, the Circuit Court of Appeals for the Third Circuit stated as follows, quoting from the record, page 31:

> "Now, while a kerf or cut in the edge of a bar was a common mechanical expedient, no one had used it in concrete reinforcement until Vandenburgh disclosed his device. But, other than a combination using a kerf, Vandenburgh disclosed nothing new in his specification. Finding his kerfed combination novel, regarding it as useful, and assuming for present purposes, as we will, that it embodied invention, there is no reason for regarding it as other than a narrow contribution to the art of a specific type of coil and bar attachment."

In sub paragraph B, page 3, the petitioner fails to state that in the Ohio case only claims 1, 2 and 3

were involved. Claim 5 was not involved and claim 5 is sufficient to sustain the judgment.

Sub paragraph C, page 3, requires no comment.

The prayers for relief in paragraph 5, page 3, are misleading and untrue as will now be pointed out. The first prayer fails to state that the patent has been held valid as to claims 3 and 5 and has been held invalid as to claims 1 and 2.

The second prayer is merely a formal one which will probably not be insisted upon as the defendant's structure is identical with the structure of the patent in suit and with the claims of the patent here in suit.

The third prayer is wrong in point of fact. No CIRCUIT COURT OF APPEALS HAS ANNULLED THE PATENT. Claim 5 stands without question in all decisions of the Appellate Courts which have passed upon them. One Court questions the validity of claim 3, but has nothing against the validity of claim 5.

The fourth prayer is in error in point of fact because the patent was not affirmed on the strength of the testimony of any one witness, but on the records of two cases in two different circuits where the matter of validity was thrashed out at great length.

The fifth prayer relates to a false issue. The matter of reissue cuts no figure here because the only claims involved were original claims which stand as though they were in the original patent as pointed out by the Circuit Court of Appeals in this case at page 17.

The sixth prayer is absurd. There is no reason for limiting by construction the scope of the claims here in suit. They are valid as they stand at their face value. The word "rigid" does not appear in the patent in suit and never appeared except as to

two claims which were eliminated at the time of the reissue. The word "rigid" never appeared in the specification and never appeared in the application as it was when originally filed. As a matter of fact, when the structure is used it is as rigid as it can be made, as will appear below, but this matter is immaterial and irrelevant to any issue in this case.

The seventh prayer is a general one which needs no attention.

In the sixth paragraph of page 4 it is contended that the plaintiff is a poor man. Assuming this to be so the point has no bearing here. The parties hereto have entered into an agreement which has been approved by the District Court by virtue of which the judgment in this case will not be collected and will not be disturbed until this Supreme Court has passed on the matter at bar and determines what shall be done.

The seventh and eighth paragraphs on page 5 are formal and require no discussion.

The Issues.

So far we have answered the petition and shown numerous errors. We have shown that there is nothing in this petition which defines these issues. We will do so for the Court and then extended argument will be unnecessary.

Claim 5 reads as follows:

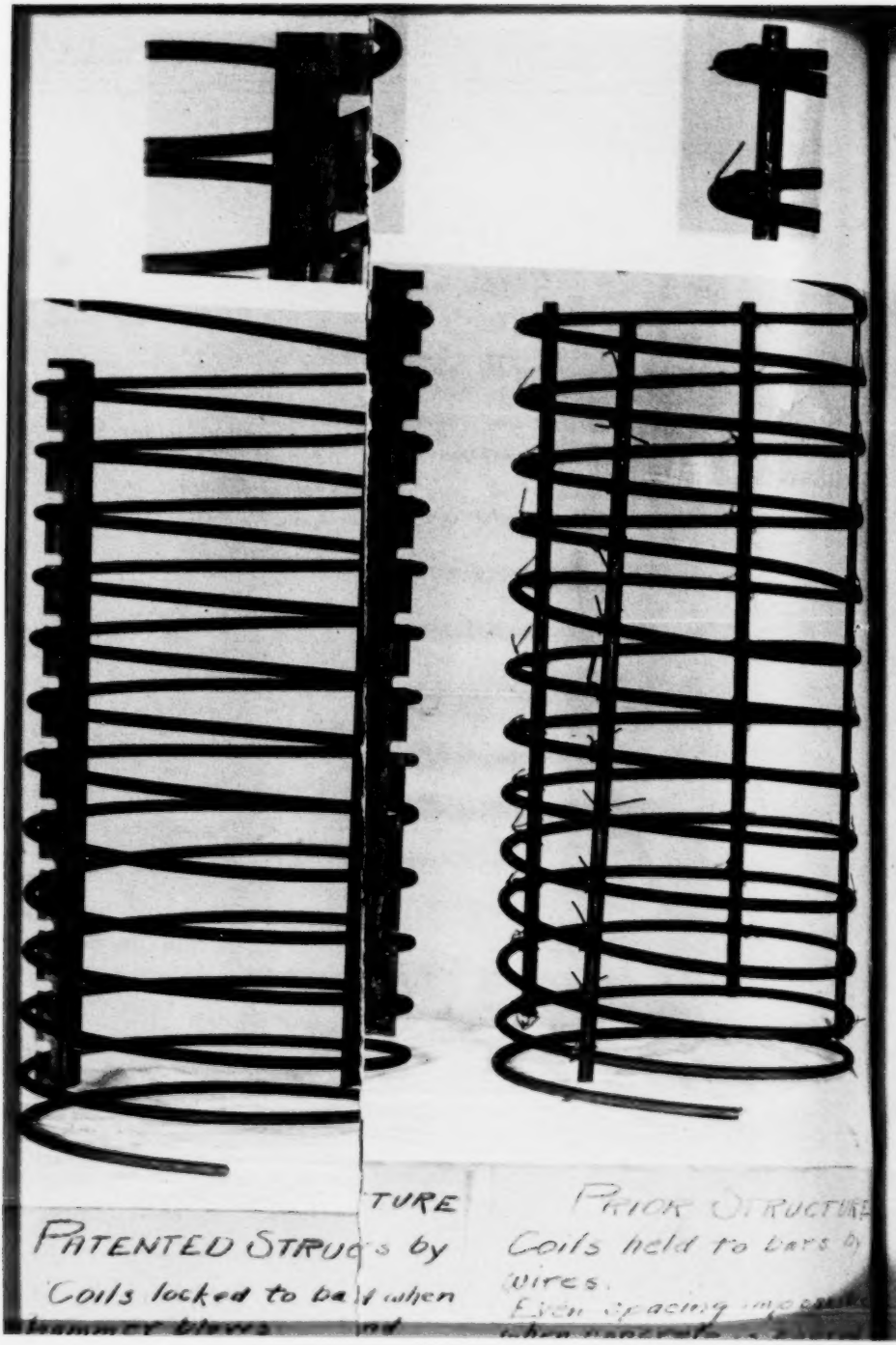
> "5. A reinforcing bar provided upon one edge with a series of kerfs disposed diagonally to the length of the bar, each having an overlapping integral spur projected toward the center of the bar and a coil disposed in said kerfs and retained beneath said spurs."

It will be noted that this claim covers but four elements, to wit:

1. A coil
2. A bar
3. A kerf or notch at one edge of the bar
4. An overlapping spur projected toward the center of the bar at each kerf which is bent down to secure a convolution of the coil.

These elements, in the combination stated, with all the details of claim 5, are what the defendant used, as above stated, so that infringement is not an issue and we can pass to the question of validity.

In the other cases decided in the Third and Sixth Circuits the respective defendants used different structures from that in the Second Circuit case, which were found not to infringe claim 3. As claim 5 is sufficient for this case, it seems best to simplify the matter before this Court by ignoring claim 3 in the argument of this brief.


TURE
PATENTED STRUC s by
Coils locked to ba l when
hammer blows
PRICK STRUCTUR
Coils held to bars by
wires.
Even spacing impo

The entire relevant prior art, as known to those skilled in the art, is shown at the right of the photograph on the opposite page. There was other paper art which need not be discussed here. It has been amply considered by the Circuit Courts of Appeals that have passed on this case. It is sufficient to say that it is not as good or nearly as good or as practical as the art which was actually used for years, which is shown at the right of the said photograph.

The coils and bars are old, but in the prior art the coils are badly secured to the bars by wires which are difficult to attach and will not hold firmly or rigidly. The coils will slip on the bars. This action cannot be prevented. Therefore, when the spirals are used in concrete columns, the spacing is uneven. This irregularity is increased by pouring and tamping, but no one can tell how much. As a column, like a chain, is no stronger than its weakest part, it is no stronger than the part where the spacing is greatest and no one knows how weak it is or what it will stand. So when this form is used, a surplus of reinforcing is required. The legend underneath tells the story. Now turn to the reinforcing at the left, the patented structure, and look at the even turns of the coil and the way in which it is locked and held. Observe that the turns do not and cannot slip under any circumstances and cannot and do not slip when the concrete is poured and tamped.

Now bear in mind that coils were introduced into this country at least four years before the invention of the patent in suit and were always wired as shown at the right. This hand wiring was the only way and the only commercial way prior to the patent in suit. These are the facts on which

validity has been determined in favor of the patent in suit as to a structure identical with that of the patent. No Court of Appeals has held otherwise. No Court of Appeals has disputed the validity of claim 5.

This question of validity is the serious issue and probably the only issue in this case. It is precisely this issue which was before the Court when it denied the petition for a writ of *certiorari* which was brought by this petitioner, as above stated.

If there be any other issue in this case, it is one which relates to profits. As above stated, $15,918.33 has been allowed and it forms the basis of the judgment of record in this case. The exact figures were furnished by the defendant below, the petitioner here, from its own records and represent the profits which it admits that it made by selling the infringing structures here complained of when infringing the claims 3 and 5 here in suit. The decisions against the petitioner are unanimous, the Master, the District Court, and the Circuit Court of Appeals for the Second Circuit having all found in favor of the plaintiff on this issue. Was this allowance right? If there be a second issue, this is the second issue. These are the only two issues and we will proceed to argue them. In this connection claim 3 may be disregarded and the case stand on claim 5, the validity of which is not disputed by any Appellate Court, and it has been twice affirmed by the Circuit Court of Appeals in the case at bar.

So the issues come down to this: should this Court allow this writ because of the question of validity and because of the question of profits when there has been no conflict of decision as to the validity of the patent as to the specific structure therein set forth and now involved?

POINT I.

The petitioner has no reasonable ground for relief in this court.

The patent is valid as to claim 5 here in suit, for reasons which we will now give.

1. This claim stands exactly as it stood in the original patent, and so all reissue matter is immaterial as to it. Gage *v.* Herring, 100 U. S. 640, 646. No reissue need be further discussed in this brief. We will consider this claim as though there had been no reissue.

2. This claim is valid for the purposes of this litigation. We recognize that only one Court of Appeals has passed on claim 5, but that decision was favorable. Furthermore, there has been no adverse decision as to this claim 5 by a Circuit Court of Appeals, and, on the contrary, the Courts of Appeals for the Third and Sixth Circuits have admitted the validity of this claim 5. Therefore, the weight of decision and authority is all with this claim and that will be sufficient to establish its validity here for the purposes of this petition.

Moreover, if this matter were open, we would show that, although the change in structure is not great, it is vital. It is the last step that counts. For years men had been seeking the right kind of reinforce for columns and not finding it. Finally, the inventor of the patent in suit comes along and makes the necessary changes and the problem is solved in a very simple and satisfactory manner. Quite an analogous case is found reported at 220 U. S. 428, Diamond Rubber Co. of New York *v.* Con-

solidated Rubber Tire Co. (31 Sup. Ct. 444). It appears in this case that there was very slight novelty which amounted to nothing more or less than a slight change in the shape of the rim with a corresponding change in the shape of the tire. This change was not great but it was sufficient to bring in a new function which greatly prolonged the usefulness of the tire. In the case at bar there is a change in the way in which the coil is held to the bar so that the coil is at all times held in the way it ought to be held, evenly and firmly, regardless of the amount of pouring and the force of tamping of concrete about this coil when the forms are poured and tamped. Other cases might be cited, but it is thought that this one is quite sufficient. It is submitted that there is more novelty in the patent here in suit than there was in the Grant patent No. 554,675, there in question. Furthermore, the suit at bar has the same tribute of litigation that this Grant patent had. It differs from the Grant patent in that no Appellate Court has rendered an adverse decision as to the claim here involved.

We have already stated as a fact, that the defendant's structure is identical with the structure of this claim, and as this is so, argument is superfluous.

Passing to this minor issue as to profits, we do not think that the petition is to be taken very seriously. Something is said beginning with page 13. The petitioner is right in saying that the Westinghouse *v.* Wagner case, 225 U. S. 604 (32 Sup. Ct. 691), governs here. Here again we agree. We do, however, differ as to the meaning which is to be attached to this decision. The plaintiff's case is clear.

Paragraphs (*a*) and (*b*) near the top of this decision read as follows:

> "(*a*) Where the infringer has sold or used a patented article, the plaintiff is entitled to recover all of the profits.
>
> (*b*) Where a patent, though using old elements, gives the entire value to the combination, the plaintiff is entitled to recover all the profits."

The plaintiff respectfully contends that he comes under either or both of these paragraphs and the Circuit Court for the Second Circuit agrees with him. Each and every detail of the patent in suit, as to these claims, is found in the petitioner's structure and the petitioner has added nothing of any substance to the structure of the plaintiff. There is no occasion for any apportionment of profits but if there should be any occasion, the burden of proof has shifted to the petitioner and the petitioner has made no effort to meet it. The minor issue of profits, if it be an issue, is so clearly against the petitioner that there is no occasion to argue it. The patent in suit is valuable and infringed and the petition has no reasonable ground of complaint because it must pay for its ill gotten gains.

POINT II.

This is not a case where the precedents justify an intervention of this court.

We have looked through all the reported cases where this Court has granted a petition for a writ of *certiorari* in a patent case, and we find that such cases readily classify themselves. We will give these classes with citations of each.

1. Cases where there have been conflicting decisions in different Circuit Courts of Appeals. This is by far the largest class. The most recent case that we know of in this class is the case of Hildreth *v.* Mastoras, 42 Sup. Ct. 20, decided November 7, 1921. (The United States citation is not known to the respondent.) Another and more famous case is the Diamond Rubber Co. of New York *v.* Consolidated Rubber Tire Co., 220 U. S. 428, above stated; 31 Sup. Ct. 444. Yet a third case, Dowagiac Mfg. Co. *v.* Minnesota M. Plow Co., 235 U. S. 641; 35 Sup. Ct. 221.

2. The second class is where the settling of the question of validity of a patent has been of great importance to the public. The most recent case of this kind, which we found, is Berlin Mills Co. *v.* Proctor & Gamble Co., 41 Sup. Ct. 75, decided December 6, 1920, 254 U. S. 256. Yet another case is that of Mineral Separation *v.* Hyde, 242 U. S. 261; 37 Sup. Ct. 82, and yet another is Carnegie *v.* Cambria, 185 U. S. 403; 22 Sup. Ct. 698.

3. The third class of cases is that where the practice has been settled. One case is that of Westinghouse *v.* Wagner above cited and another is the Dowagiac case, above mentioned, and yet another is that of Brill *v.* Peckham, 189 U. S. 57; 23 Sup. Ct. 562.

4. The last class is that where the law has been interpreted and settled. One of these cases is William Cramp & Sons *v.* International Curtis, 246 U. S. 28; 38 Sup. Ct. 271, and another is Marconi *v.* Simon, 246 U. S. 46; 38 Sup. Ct. 275. Yet another

case is Chapman *v.* Wintroath, 252 U. S. 126; 40 Sup. Ct. 234.

The case at bar comes under none of these heads and is obviously one of the kind of cases that this Court does not find it necessary to consider.

POINT III.

The United States is not entitled to any relief here.

The United States is not a party to this suit. The litigation is private litigation between private parties. It has filed a brief of a page and a half stating in substance that it would like to see this petition granted because the United States has another case pending against it under the same patent, etc.

There is nothing in the brief of the United States which throws any light of any kind whatsoever on any issue in this case. This brief tries to create a prejudice in behalf of one litigant against the other without giving any valid reason for this prejudice. We never before heard of the United States Government trying to intervene in a case so as to create a prejudice without a reason.

We believe that this practice should be discouraged and that this brief should be ignored if, it is filed, and we will treat it in this way and request *this Court* to do the same.

Conclusion.

It is the contention of the respondent that this petition for a writ of *certiorari* should be denied because the petitioner is not entitled to any relief on the merits of the case and because the case belongs to a class as to which this Court has steadfastly refused to intervene, regardless of the merits.

Respectfully,

GEORGE E. VANDENBURGH,
By O. ELLERY EDWARDS,
for Plaintiff-Respondent.

CARLOS P. GRIFFIN,
O. ELLERY EDWARDS,
JOSEPH W. COX,
of Counsel.

Dated New York, January 9th, 1922.

No 7[redacted]273

WM. R. ST

IN THE

Supreme Court of the United States

GEORGE E. VANDENBURGH,
Complainant-Petitioner,

vs.

TRUSCON STEEL COMPANY,
a Corporation,
Defendant-Respondent.

Petition for a Writ of Certiorari and Brief In Support of the Petition

---

CARLOS P. GRIFFIN,
711-714 Pacific Bldg.,
San Francisco, Calif.
For Petitioner.

IN THE

SUPREME COURT

OF THE

UNITED STATES

GEORGE E. VANDENBURGH,
Complainant-Petitioner,

vs.

TRUSCON STEEL COMPANY,
a Corporation,
Defendant-Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SIXTH CIRCUIT.

To the Honorable, The Chief Justice of the United States, and the Associate Justices of the Supreme Court Thereof, Constituting the Supreme Court of the United States.

Your Petitioner, George E. Vandenburgh, a citizen of the United States and a resident of the State of California, respectfully represents:

1. That on or about the 18th day of September, A. D. 1919, he filed his bill of complaint in the United States District Court for the Northern District of Ohio, Eastern Division at Cleveland, Ohio, against the Truscon Steel Company, a corporation duly organized and existing under the laws of the State of Ohio and having a place of business at Youngs-

town in the State of Ohio, alleging the infringement by said corporation of reissue patent No. 14,182 granted to him August 15, 1916.

2. That thereafter, to-wit, on or about June 8, 1920, the trial of said cause was had before Judge Westenhaver at Cleveland, Ohio, whereupon on October 18, 1920, an order was filed dismissing said bill of complaint, whereupon on or about November 5, 1920, an appeal petition to the United States Circuit Court of Appeals for the Sixth Circuit was filed with the Clerk of the United States District Court at Cleveland, Ohio, said appeal petition being accompanied by an assignment of errors which was duly filed, whereupon upon November 6, 1920, an order was entered allowing the appeal and fixing the bond therefor. Thereafter, to-wit, upon December 2, 1920, the bond was duly filed and citation issued. Thereafter, to-wit, on or about November 14, 1920, said appeal was heard at Cincinnati, Ohio, by the Honorable Judges of the United States Circuit Court of Appeals for the Sixth Circuit, whereupon said appeal was duly submitted. Thereafter, to-wit, on or about January 8, 1922, a decision was rendered by said Circuit Court of Appeals ordering the affirmance of the Decree of the United States District Court below, case No. 3587.

3. That on or about the 7th day of February, 1917, your petitioner, George E. Vandenburgh, filed his bill of complaint in the District Court of the United States for the Southern District of New York, against the Concrete Steel Company, a corporation duly organized and existing under the laws

of the State of Delaware, and having a place of business in the City of New York, State of New York.

4. That thereafter the trial of said cause was had, whereupon Judge Hough, who heard said cause ordered the dismissal of said bill of complaint.

5. That thereafter an appeal was taken to the Circuit Court of Appeals for the Second Circuit upon said dismissal, whereupon the decree of dismissal was ordered reversed, and certain claims of said patent were held to be valid and infringed.

6. Such proceedings were then had before the Master as to cause him to report that there was due from Defendant to the Plaintiff the sum of $15,-918.33.

7. Thereafter exceptions were taken and the matter came on to be heard before the United States District Court for the Southern District of New York, whereupon the Master's order was confirmed. Thereupon an appeal was taken to the Honorable Circuit Court of Appeals for the Second Circuit, and such proceedings were had that on the 14th day of December, 1921, the Circuit Court of Appeals affirmed the decision of the District Court in all things.

8. Thereupon defendant, the Concrete Steel Company presented to the Honorable Supreme Court of the United States a petition for a writ of certiorari praying that the decree of the Circuit Court of Appeals for the Second Circuit be sent to the Supreme Court of the United States for revision, whereupon on or about January 30, 1922 said petition was granted by this Honorable Court.

9. Your petitioner further represents that on or about February 13, 1917, he filed his bill of complaint against the Electric Welding Company, a corporation duly organized and existing under the laws of the State of Pennsylvania, having a regular and established place of business in Pittsburgh, Pa., in the United States District Court in and for the Western District of Pennsylvania, at Pittsburgh, Pa., alleging therein the infringement of the same reissued patent No. 14,182.

10. That thereafter such proceedings were had in said United States District Court to cause the dismissal by his Honor, Judge Orr, of said bill of complaint, whereupon an appeal was taken to the United States Circuit Court of Appeals in and for the Third Circuit sitting at Philadelphia, Pa.

11. That said Court of Appeals affirmed the decision of the Court below, stating in its decision *inter alia*: "Finding his kerfed combination novel, regarding it as useful, and assuming for present purposes, as we will, that it embodied invention, there is no reason for regarding it as other than a narrow contribution to the act of a specific type of coil and bar attachment." Whereupon a petition for rehearing was duly filed and denied, after which the petition for certiorari to this Honorable Court was filed and thereafter denied.

12. Your petitioner, George E. Vandenburgh, is informed and believes that the decision of the Circuit Court of Appeals for the Third Circuit as filed is erroneous, and that the decision of the Circuit Court of Appeals for the Sixth Circuit as filed is

erroneous, and this Honorable Court should require the present cause to be certified to it, for its review and determination in accordance with the law in such cases made and provided, under which such review of decisions otherwise final is had to the end that justice may be done this petitioner.

13. Your petitioner respectfully shows that the decision of the Circuit Court of Appeals for the Third Circuit is erroneous for the following reasons:

A. The defendant herein by its solicitor W. F. Guthrie, filed a brief *amicus curiae* in the case of Vandenburgh vs. Electric Welding Company in the Circuit Court of Appeals for the Third Circuit in which it states: "the constructions of the respective defendants are substantially and essentially the same.", and the constructions are identical mechanically.

B. The evidence in the case against the Concrete Steel Company was prepared from the evidence given on an extended trial of the case against the Electric Welding Company herein mentioned and was merely reduced in quantity upon appeal, upon which record the Concrete Steel Company has been held to infringe claims 3 and 5.

C. That the evidence in all of these cases shows that concrete reinforcing consisting of spirals with integral fasteners identical with that of plaintiff's patent have substantially displaced other forms, whereas the Circuit Court of Appeals for the Sixth Circuit finds that "We are not impressed that the

advance in reinforced concrete construction is due in any substantial measure to Vandenburgh's contribution."

D. That said decision is erroneous in not admitting the claims of the Vandenburgh patent to any mechanical equivalency notwithstanding the fact that the construction of the defendant herein is mechanically and identically the same in function.

E. That said decision and the decision of the Circuit Court of Appeals for the Second Circuit in the case against the Concrete Steel Company are erroneous in that claim 1 of said reissued patent is held to be broader than the original claim 1, whereas the fact is that the original claim 1 did not define the means for securing the coils to the longitudinals, and whereas the reissued claims define the securing means as being a part of and integral with the longitudinals and secured thereto by having said integral means bent down upon the spirals.

F. That the record clearly demonstrates the validity of claims 1, 2, 3, and 5 and shows that following the original patent not less than six patents followed the Vandenburgh idea of using integral means on the longitudinals for securing the spirals in place.

G. That said decision is further erroneous in not accepting the uncontradicted testimony of plaintiff and another witness as sufficient to fix the date of invention, neither witness having been in any way impeached.

H. That the decisions of the Court of Appeals for the Sixth and Second Circuits conflict with each

other, the subject matter and the evidence being substantially identical in each case.

I. That said decision is further in error in accepting insufficiently proven printed publications as evidence.

J. That said decision is in error on all the grounds named in the assignment of errors in the court below.

14. *Wherefore your petitioner prays* this Honorable Court to issue its writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit, commanding it to transmit the record of this cause to this Court for the correction of the errors in the decision of the Court of Appeals aforesaid to the end that justice may be done, and such order and decree may be entered in the premises as right and justice may require.

GEORGE E. VANDENBURGH,
Plaintiff-Petitioner.
By CARLOS P. GRIFFIN,
His Counsel.

Brief for Petitioner for Certiorari to the Circuit Court of Appeals for the Sixth Circuit.

No. 3587.

U. S. CIRCUIT COURT OF APPEALS,
SIXTH CIRCUIT.

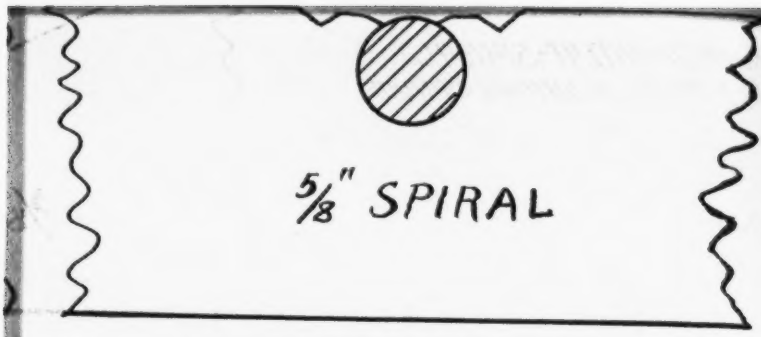
GEORGE E. VANDENBURGH,
Complainant Petitioner,

vs.

TRUSCON STEEL COMPANY,
a Corporation,
Defendant Respondent.

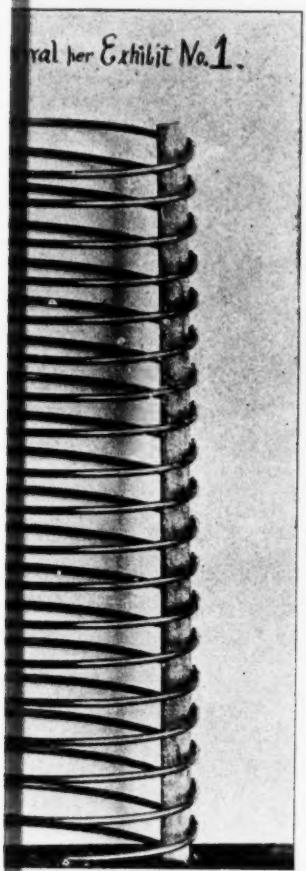
PRELIMINARY STATEMENT.

This case presents a conflict of decisions between the Circuit Courts of Appeal for the Second Circuit and for the Sixth Circuit, on the same patent and the same issues. This conflict has been deemed sufficient to justify granting the petition for certiorari of the Concrete Steel Company, and it is believed by counsel that justice cannot be done unless this petition be also granted. The decision on the last appeal at New York and the Sixth Circuit decision are both printed herein. One holds for infringement and the other against infringement.



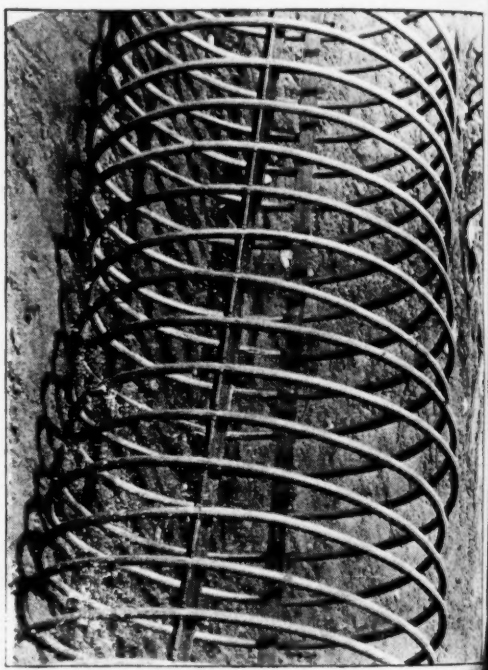
DEFENDANTS PRONGS.

lding Co.—Spiral.



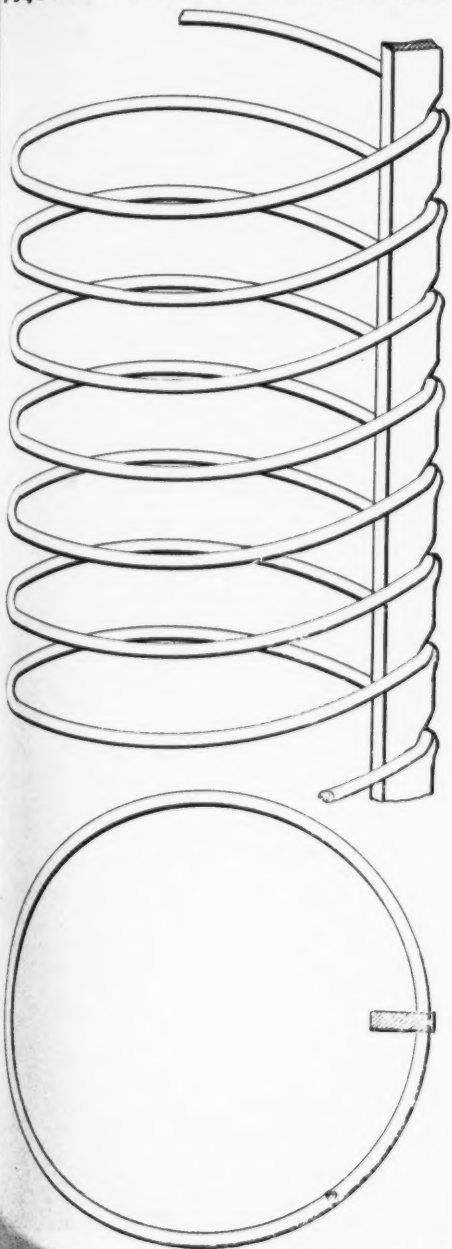
TRUSCON STEEL CO - SPIRAL

Exhibit of Defendant on motion for preliminary injunction

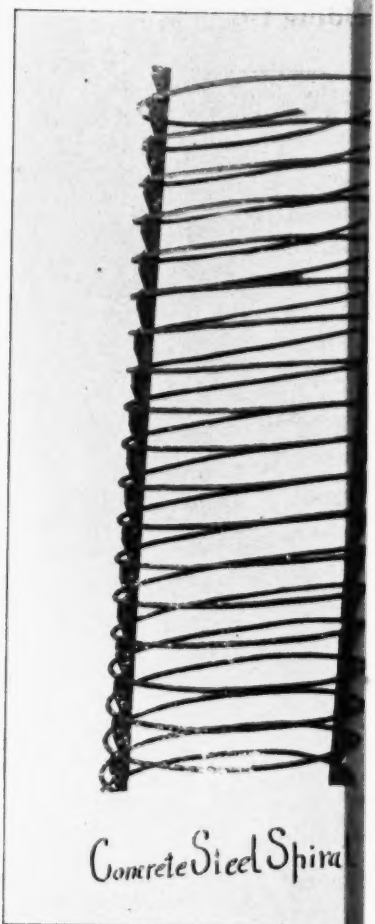


olds coils on one side and prongs on other.

VANDENBURGH-PATENT-SPIRALS
FIGURE 4. WITH ADDITIONAL SPIRALS.



PLAINTIFF



Note each bar has a wide radial plane with no

THE ISSUE.

The construction of the patent consists of a spiral concrete reinforcing secured to longitudinals by prongs thereon bent down on the spirals. Defendant's construction consists of spiral concrete reinforcing secured to the longitudinals by two prongs thereon bent down on the spirals. There is no essential difference between the two, though the shape of the notch in which the spiral is seated varies. One is the full mechanical equivalent of the other in parts and function.

The inserted sheet is copied from the record, showing in addition a drawing taken from full size reinforcing the actual shape of the prongs in each case. This can also be seen on page 217 of the record.

PETITIONER'S PATENT VALID.

The decisions of every Circuit Court of Appeal before which this case has come, have agreed that claim 3 of the patent is valid in the body of the decision, regardless of the action taken in sustaining or reversing the court below. The art clearly shows the development right up to the Vandenburgh patent and then turns over and at least six patents are then found which use the construction he started.

PETITIONER ENTITLED TO BROAD PROTECTION.

It is clear from the art that Vandenburgh is the first to produce the combination of his claims, and the fact that others at once copied him shows that in his limited field he should be broadly protected.

Sly vs. Russell, 189 Fed. 61, Sixth Circuit.

Judge Lurton speaking in cited cases says:

To be entitled to the benefit of the doctrine of equivalents, it is not necessary that the patent shall be a pioneer in the broad sense of that term.

> "In view of this situation, we do not think the patentee should be held limited to the precise form of his crushing agent, in the absence of words of express limitation thereto."
>
> "We do not construe the language of the specification and claim as expressly so limiting it."
>
> Decision by Judge Knappen.

Diamond Co., vs. Consolidated Rubber Co., 220 U. S. 428:

> "It is urged that such capacity (the tipping of the tire) is not recited in the specifications of the patent, and was unknown to Grant. . . ." (Here collapsibility of the spiral.)
>
> "It was certainly not an exact repetition of the prior art. . . .
>
> "It possesses such an amount of change from the prior art as to have received the approval of the Patent Office. . . .
>
> "Its simplicity should not blind as to its character. . . .
>
> "Knowledge after the event is always easy, and problems once solved present no difficulties. . . .
>
> "It is certainly not necessary that he understand or be able to state the scientific principles involved and it is immaterial whether he can stand a successful examination as to the speculative ideas involved."
>
> "And we may say in passing that the elements of a combination may be all old. In making the

combination the inventor has the whole field of mechanics to draw from."

"Decree affirmed."

Some one was entitled to a broad claim in that art, and that some one is the man who gets the patent on the first filed patent application, in this case Vandenburgh. Various degrees of narrow and technical constructions of claims have been used to defeat the patent, Judge Westenhaver says of one of these differences: "These differences in construction are as substantial as those held not to infringe by the Third Circuit Court of Appeals." "This however, seems to me to be too narrow a ground to dispose of this controversy." "If . . . the patent is valid . . . infringement could not be repelled by such an unsubstantial difference." The fact is the two things are substantial mechanical duplicates.

THE REISSUE.

The reissue was made as soon as the plaintiff ascertained the necessity therefor, (see page 26 of the record) present counsel himself telling the inventor of the necessity therefor for the first time about the time of filing the reissue application. The reissue oath will be found at page 458 of the record.

Obvious as the needed corrections were to one looking at the patent for the first time who was skilled in the art, they would not make an impression on a man who is a mason or bricklayer such as this man was.

The delay in making the reissue application is unnecessary to explain for the claims are actually

narrower in the reissue than in the original patent, but he explains his inability to place the reinforcing on the market as due to sickness and loss of money and other causes, see pages 95 and 96 of the record.

That the patentee is not affected by inability to market his invention, is fully decided in

Continental Bag Co. vs. Eastern Co., 210 U. S. 405;

and that narrowed claims are not void for laches has been decided in

Motion Picture Co. vs. Laemmle, 214 Fed. 787, where it was said, "Nowhere has it been held that narrowed claims are void for laches."

ACTION OF THE UNITED STATES SOLICITOR GENERAL.

The Solicitor General for the United States has joined the Concrete Steel Company in asking that the petition be taken up. Apparently the only reason the Solicitor General gives for his action in taking the matter up in the Concrete Steel Company case is given in paragraph 3 of his brief *amicus curiae* which is as follows:

> "That a decision upon the matters set forth in the petition for the writ of certiorari if favorable to petition, that is, the United States, would relieve the United States of the expense and labor of defense as to those claims in the Court of Claims suit, and would thus avoid a multiplicity of suits."

Just why the Solicitor General of the United States should be so solicitous of the interest of the

United States as to intervene in a private suit involving a patent which has already held valid by three Circuit Courts of Appeal is not quite clear, but in any event the plaintiff should at least be given the same hearing that the Solicitor General has been offered and the present petition be granted.

It is believed that this petition should be granted in order that this Honorable Court may once for all settle this controversy, along with the controversy in the Concrete Steel case, wherein the same plaintiff has his patent at stake.

Respectfully submitted,
GEORGE E. VANDENBURGH,
by CARLOS P. GRIFFIN, *His Counsel.*

APPENDIX A.

FILED
JAN 9 1922
ARTHUR B. MUSSMAN,
CLERK

No. 3587

UNITED STATES
CIRCUIT COURT OF APPEALS,
SIXTH CIRCUIT.

GEORGE E. VANDENBURGH, *Appellant,* vs. TRUSCON STEEL COMPANY, *Appellee.*	APPEAL from the District Court of the United States for the Northern District of Ohio.

Submitted November 14, 1921.
Decided January 4, 1922.

Before KNAPPEN, DENISON *and* DONAHUE, Circuit Judges.

KNAPPEN, Circuit Judge: Suit for infringement of claims 1 and 3 of reissued patent No. 14,182 (August 15, 1916) to Vandenburgh. The original patent,

No. 841,741, was issued January 22, 1907. The application for reissue was filed July 1, 1916. The invention relates generally to reinforced concrete construction. Its prominently-stated specific object is to "provide a reinforcing bar with one of more spirally-disposed coils secured to the bar so as to provide an extended area of contact adapted to resist strain longitudinally and laterally on the bar, and to form a truss within the body of concrete, etc." As a preferred means of securing the coils to the bar the specification discloses "a series of kerfs in one face of the bar inclined away from the center of the bar toward the opposite ends thereof," the coils being "seated within these kerfs and held therein by means of the integral spurs, which are forced downward upon the coils when inserted and permanently retain them in position." The specifications, considered in connection with the drawings, plainly show an integral spur overlapping the kerf, which when forced downward upon the coils holds them rigidly in position. Claims 1 and 3 read as follows:

"1. A concrete reinforcing consisting of a bar having a plurality of integral spurs, and a spiral coil permanently secured thereto by having the spurs bent down on the several coils, the coils extending beyond and free of the bar at the opposite side therefrom to the securing point."

"3. A reinforcing bar provided upon one edge with a series of kerfs each having an integral overlapping spur, and a coil disposed in said kerfs, each convolution thereof being retained beneath one of said spurs."

The defenses are invalidity of the reissue, lack of invention and noninfringement. The district court held claim 1 invalid as too broad, and claim 3 void for lack of patentable novelty, if construed broadly enough to embrace defendant's structure. The appeal is from a decree dismissing the bill.

The district court was plainly right in holding claim 1 invalid. As will later appear, the only novelty in plaintiff's conception is in the specific method of attaching the coils to the bar by kerfs therein and integral spurs rigidly securing the coils within the kerfs. The claims of the original patent, which were replaced by claims 1 and 2 of the reissue, in terms call for a rigid fastening. The omission of the requirement of rigidity in claims 1 and 2 was apparently intended to cover the feature of collapsibility found in later devices. Claim 1 of the reissue is thus unwarrantably broad. The same conclusion has been reached by the Circuit Courts of Appeals of both the second[1] and third[2] circuits. Claim 3 of the reissue differs from the third claim of the original patent only in the substitution in the reissue of the word "edge" for the word "end" in the original. This is plainly merely a correction of a clerical error. It thus becomes unnecessary to give further consideration to the question of the validity of the reissue.

The real date of plaintiff's invention is more or less material in determining what is prior art as related to invention. Plaintiff's original application

[1] *Vandenburgh* v. *Concrete Steel Co.*, 258 Fed., 143.
[2] *Vandenburgh* v. *Electric Welding Co.*, 263 Fed., 95.

was filed May 9, 1906. He attempted to carry the actual date of his invention back to 1903, and offered some testimony tending to show such earlier invention date. The trial judge held the testimony not sufficient to establish such earlier date. We can not disturb this conclusion. The evidence consisted solely of the oral testimony of plaintiff and another witness, taken in open court. Under well-settled rules, the burden rested heavily upon plaintiff to establish the fact of the asserted earlier date of invention to the satisfaction of the court,—whether or not such satisfaction is required to be beyond a reasonable doubt. *St. Paul Plow Works* v. *Starling,* 140 U. S., 184, 198; *Clark Co.* v. *Willimantic Co. ibid.* 481, 492; *Moline* v. *Rock Island* (C. C. A., 7), 212 Fed., 727, 732; *Barber v. Otis* (C. C. A., 2), 271 Fed., 171, 180. The question presented was one of fact only, depending upon the weight to be given this oral testimony; and the trial court's conclusion thereon must be accepted here unless the evidence decidedly preponderates against it. *Pugh* v. *Snodgrass* (C. C. A., 6), 209 Fed., 325. Assuming that we are at liberty, upon this record,* to consider this testimony, it is enough to say that the evidence does not preponderate against the conclusion of the trial judge.

Turning to claim 3: The art of steel-reinforced concrete construction generally was highly developed before Vandenburgh entered the field. It had

*The testimony is not certified as settled and approved by the trial judge, as required by General Equity Rule 75 (b). It appears to have been merely stipulated by counsel.

been applied not only to the construction of bridges, spandrel walls, dock walls, retaining walls and fireproof floor construction, but specifically to beam, girder and column construction in manufacturing and other buildings.' The art, generally speaking was already old and crowded, although the more extensive and rapid use of metal-reinforced concrete came a little later. Truss reinforcement of concrete beams was also old, through the use of radially disposed projections from the tension member (either perpendicularly or obliquely thereto), as well as otherwise. See *Trussed Concrete Steel Co.* v. *Goldberg* (C. C. A., 6), 222 Fed., 506, 509 *et seq.* The art with which we are here concerned relates to that form of column construction called "column hooping." While Vandenburgh's invention seems more specially adapted to beam and girder construction, it is declared by the specification to be applicable to column construction as well; and we shall treat the disclosure not only as so applicable but as intended to cover a plurality of vertical reinforcing or spacing members around and upon which steel reinforcement is wound in spiral form. Vandenburgh was not a pioneer in this field. Hyatt (by British patent, 1874), and Lee (also by British patent, in 1885) had disclosed iron bands looped spirally to reinforcing members, the spirals being riveted to each other or to the vertical reinforcement. Kiesserling (German

'We may refer in this connection to the following decisions of ths court: *Ferris Concrete Steel Co.* v. *Concrete Steel Co.*, 206 Fed., 666; *City of Akron* v. *Bone*, 221 Fed., 944; *Detroit Iron & Steel Co.* v. *Carey*, 236 Fed., 924; *Luten v. Whittier*, 251 Fed., 590.

patent, 1894) had disclosed columnar reinforcement by way of a series of loops attached to vertical members by square notches therein. Column hooping seems to have become active abroad about the year 1902, and in the United States about a year later; and in articles published in 1902 and 1904 column hooping was described and illustrated, the 1902 publication disclosing notches on the exterior faces of the supporting members to contain and hold the spirals. Considere (United States patent, 1904) disclosed a reinforcement consisting of longitudinal rods and "independent helicoidal coils of metal . . . surrounding the core and rods," the coils apparently not being attached to the longitudinal members; and the next year published his researches in connection with the use of "continuous helicoidal spirals." In March, 1906, the *Engineering News* published an illustrated description of metal reinforcement for columns, showing spiral reinforcement retained in place upon the vertical members between projections from the surface thereof.

It is thus apparent that Vandenburgh's invention, at the best, consisted only in the method of attaching the spiral loop to the vertical or spacing member. As already said, his method of attachment was by means of a kerf cut at an angle inclined to the edge of the vertical or spacing member, which thereby created an overhanging spur integral with the upright, the hammering down of this kerf and spur making a rigid connection between the spiral and the upright. It is true that this particular method

of attaching the loop to the upright was new as al-applied to the art of metal-reinforced concrete. But, as already shown, continuous spirals in connection with spacer bars were old in that art. It was old in metal construction generally to use that method of fastening wires to uprights, as shown by Norwood (patent, 1896) in the connection of longitudinal parallel wires with the cross-bars of sand-screens, where "diagonal slots forming acute-angle hooks" receive the wires, the hooks being "bent down to hold such wires in place." The same method had been disclosed for the fastening of fence wires to posts of cement construction, the attachment of course not being directly to the cement. We recognize that the use of diagonal kerf and overhanging spur method of connection in a non-analogous art did not anticipate the combination claim in question; but we are not considering anticipation, but invention, and the prior art in question is thus not irrelevant. *Day* v. *Mountain City Mill Co.* (C. C. A., 6), 264 Fed., 963, 964-5. The adaptation of an inclined kerf and overhanging spur connection to the reinforced concrete art amounted only to a common mechanical expedient. *Berger Mfg. Co.* v. *Trussed Steel Concrete Co.* (C. C. A., 6), 257 Fed., 741.

The defendant does not use the diagonal kerf and overhanging spur. Its coil is located in a rectangular cut in the edge of the upright, there being thus no overhanging spur, and the coil is held in position by hammering or "peening" down the metal at the edges of the rectangular cut sufficiently to hold the coil in position, not rigidly but loosely enough to permit

the collapsing of the structure for purposes of shipment. Defendant's method of fastening was also old in the metal construction art, being shown in Prescott & Bennett's 1891 sand-screen patent. The patent in suit has been considered by the Circuit Courts of Appeals of the second and third circuits. In the former (*Vandenburgh* v. *Concrete Steel Co., supra,*) claim 3 was held to disclose invention and to be infringed by a construction which seems to be substantially similar to that involved here. In the Third Circuit (*Vandenburgh* v. *Electric Welding Co., supra*) claim 3 was held limited by the prior art to a bar with kerfs in which the attached coil is placed, and a tongue or spur overlapping the kerf and holding the coil in place, and as so limited not infringed by a fastening consisting of a lip or clip struck up from the face of the spacing member.

We are not impressed that the advance in reinforced concrete construction is due in any substantial measure to Vandenburgh's contribution. Our conclusion is that, assuming for the purposes of this opinion that the claim in question involves some measure of invention, it is so narrow as to be practically limited to the specific method of fastening disclosed, and that it cannot be extended to cover defendant's method.

The decree of the district court is accordingly affirmed.

APPENDIX B.

UNITED STATES
CIRCUIT COURT OF APPEALS.

FOR THE SECOND CIRCUIT.

GEORGE E. VANDENBURGH,
Plaintiff-Appellant,
against
CONCRETE STEEL COMPANY,
Defendant-Appellant.

Before
ROGERS,
MANTON
and MAYER.
Circuit Judges.

CARLOS P. GRIFFIN and O. ELLERY EDWARDS for plaintiff.

LUCIUS E. VARNEY, THOMAS J. JOHNSTON and MANVEL WHITTEMORE for defendant.

Appeal from final decree of the District Court of the Southern District of New York in favor of plaintiff. Both parties appeal.

MAYER, *Circuit Judge*:

This is the ordinary patent infringement suit which now comes here on appeal from a final decree adjudging that plaintiff recover from defendant profits in the sum of $15,918.33 with interest from the date of the Master's report.

Originally, the District Court dismissed the bill for non-infringement but the decree was reversed for the reasons stated in 258 F. R. 143.

Thereafter, in due course, the usual interlocutory

decree was entered, *inter alia,* referring the accounting to a Special Master. The Special Master reported that plaintiff was entitled to recover profits but not damages. The District Court sustained this report. Both the District Judge and the Master wrote opinions fully and carefully discussing the questions involved.

1. The patent has been considered by several courts, *Vandenburgh* v. *Electric Welding Company,* 259 F. R. 579, 263 F. R. 95, *certiorari* denied 253 U. S. 497, *Vandenburgh* v. *Truscon Steel Company,* opinion of District Court for the Northern District of Ohio, Eastern Division dated September 23, 1920; and there have been differences of opinion.

The law of this case, however, is that set forth in this Court's opinion per Judge Ward in 258 F. R. *supra.* The gist of the case may be recalled by the following quotation:

> "These claims . . . (3 and 5 of the reissue) . . . should be construed consistently with the specifications, which are also literally the same in each patent, as meaning that the spiral coil is rigidly connected with the longitudinal bar at each point of contact. So construed the claim describes a continuous spiral rigidly and integrally connected with kerfs and spurs in the bar constituting a trusslike structure within the body of the concrete resisting lateral and longitudinal strains and which can be more cheaply manufactured than if the spiral were riveted or welded to the bar at each point of contact.
>
> The defendant's witness Cummings frankly admits that this form of reinforcing a structure was new in cement work and has come into general use. . . . The defendant's structure when

> set up to receive the concrete is exactly the same as plaintiff's except that the spiral coil is not rigidly fixed by kerfs and spurs on the bar. This enables the structure to be collapsed when not in use, a commercial improvement for purposes of shipment but which does not justify the defendant's appropriation of the plaintiff's structure."

Defendant's collapsible feature thus did not avoid infringement but merely added a commercial improvement for purposes of shipment.

It is contended by defendant that the case is one for apportionment of profits and that Court and Master erred when they ascribed (as did plaintiff) the whole value of defendant's structure as a commercial article to the Vandenburgh patent feature.

The theory of defendant is that all or, in any event, part of the commercial value of defendant's structure was due to its collapsible feature and, but for this, the structure would not have been salable. Therefore, defendant contends that when plaintiff has not adduced any testimony that the structure is salable when not collapsible or of the profits due to collapsibility, plaintiff has failed to carry the burden of proof cast upon him. *Westinghouse* v. *Wagner Mfg. Co.*, 225 U. S. 604.

Defendant did not introduce any testimony in respect of apportionment. It relied on its contention that because plaintiff failed to produce testimony upon which an apportionment could be based, he would be entitled to nominal damages only.

It may be assumed from the testimony of plaintiff's witnesses that if the structure were shipped

there would be a saving in freight. It may, also, be assumed that in some instances, owing to competitive conditions, the determining factor in a sale might be this saving. Yet, it is entirely plain that there never would have been any sale whatever without this Vandenburgh feature. It was the Vandenburgh "form of reinforcing structure" infringed by defendant, which was new in the art. The advantage according to the expert Thayer, over the method, in the prior art of riveting or wiring is that "the method of wiring used up a good deal of the section of the bar. It was that way and riveting is also expensive."

Thayer also mentioned the collapsible feature as a part of what he called the "Vandenburgh method," but, with this, we do not agree, in view of our former decision.

It is entirely clear, however, that defendant would never have sold a dollar's worth of its devices had it not availed of plaintiff's patent. The cheapness of manufacture was due to plaintiff's disclosure, which, therefore, created defendant's device as a commercial commodity. Because, then, in some instances, the additional feature of collapsibility saved freight, it cannot be said that this feature placed the burden of showing apportionment on plaintiff.

The test is whether the invention of the patent gives the whole value to the infringing device. Obviously, it must in a case where the sale of the article would be impossible without availing of the disclosure of the patent and, where the additional feature had no relation to the structure, *cua* structure, or to

its shipment as such but only to reduced expense in transportation, accomplished by means which in no manner changed the character of the structure when used for the purposes for which it was designed.

If, therefore, the saving of freight was an accounting element, the burden of so showing was on defendant.

Westinghouse v. *Wagner Mfg. Co., supra.*

This is peculiarly illustrated in this case.

Barbour, who was in charge of the details of the sales in defendant's New York office, was called by plaintiff. He testified as follows:

> "Q. 41. In any event, these spirals are shipped collapsed, connected to some longitudinal bars, you understand that to be the subject matter of this suit? A. I understand that to be the subject matter of this suit, but the spirals are not all shipped in that way, not in my territory.
>
> Q. 42. What percentage are shipped in any other way? A. You mean the territory I know about, that is within New York City or a radius of 25 miles of New York City?
>
> Q. 43. Where are you selling? A. In New York City or a radius of 25 miles from New York, they ship what we call field assembled; that is, the coil wire is shipped, it is coiled to diameter and shipped separate as a coil, then the angles are punched and shipped separate, that is on account of a restriction.
>
> Q. 44. Assembled by you or assembled by the contractor? A. By the contractor on the job, what we call field assembly; that is on account of a restriction, I think it is, Metal Lathers Union; they won't allow us—they won't allow I don't know as I should say 'us,' but they won't allow

the contractors to use spiral in any other way in New York City or within a radius of 25 miles of New York."

The foregoing shows that a considerable business was done by defendant without the collapsible feature because of the "Union" restriction and, thus, destroys any contention that collapsibility was, in all instances, an indispensable requisite.

From what has been said, *supra,* there was no obligation upon plaintiff to apportion the profits between the Vandenburgh features and the prior art. There was no standard of comparison and, on the evidence in this case, there was no occasion for that reason to apportion profits. See *Philadelphia Rubber Works Co.* v. *U. S. Rubber Reclaiming Works,* F. R. , recently decided by this court.

2. On the facts in the case as clearly set forth by the Master and approved by Judge Knox, there was no evidence which afforded any basis for fixing the amount of a reasonable royalty. We think this question was wholly one of fact to be disposed of on settled principles which do not call for exposition.

3. Plaintiff urges that he is entitled to recover interest as six per cent as to each item of profit from the date thereof as set forth in defendant's account. There is no evidence of wanton infringement. The mere fact that the courts held different views as to the claims of the patent is sufficient to negative any such suggestion.

The Philadelphia Rubber Works Co. v. *U. S. Rubber Reclaiming Works, et al.*

Metallic Rubber Tire Company v. *Hartford Rubber Works Company,* *F. R.* .

In an infringement case, where there is a genuine controversy, it is settled in this circuit, that interest runs from the filing date of the Master's report.

Oehring against *Fox Typewriter Co.*, 251 F. R. 584.

Metallic Rubber Tire Co. v. *Hartford Rubber Works Company, supra.*

The Philadelphia Rubber Works Co. v. *U. S. Rubber Reclaiming Works, et al., supra.*

4. Plaintiff, contrary to defendant's contention, was not guilty of laches and there were no intervening rights. Plaintiff has recovered profits only from August 15, 1916, the date of the reissue patent.

The decree is affirmed without costs on this appeal.

In view of the results there is no occasion to deal further with the Master's motion to dismiss or affirm as to his allowance.

IN THE

Supreme Court of the United States

GEORGE E. VANDENBURGH,
Petitioner-Appellant

vs.

TRUSCON STEEL COMPANY,
Respondent-Appellee

No. 273
October Term
1922

Motion to Advance for Hearing, or to Consolidate for Hearing, with Concrete Steel Company, Petitioner-Appellant vs. George E. Vandenburgh, Respondent-Appellee, Number 238, October Term, 1922.

Truscon Steel Company moves the Court to advance this case for hearing immediately following hearing of above companion case number 238, or to consolidate this case for hearing therewith, for reasons in memorandum following:

TRUSCON STEEL COMPANY,
by W. F. Guthrie, Solicitor and of Counsel
c-o Truscon Steel Co., Youngstown, Ohio

CONSENT TO MOTION

Counsel for moving party has sent manuscript copies of foregoing motion and grounds to counsel for other parties.

Mr. J. T. Johnson, of Counsel for Concrete Steel Co., writes under date of October 17, 1922, advising as to practice in presenting motion, and saying:

"Of course, I will not oppose a motion to advance, but, on the contrary, authorize you to say that we concur in the motion to advance, though we prefer that the cases shall not be consolidated; but I will not resist the direction of the Court, if it shall conclude to consolidate them, as I think the time will be sufficient."

Mr. Carlos P. Griffin, Counsel for Vandenburgh, writes under date of October 18, 1922, enclosing copy of manuscript motion to advance, the body of which is as follows:

"Now comes CARLOS P. GRIFFIN and W. F. GUTHRIE, counsel for the parties herein, and moves this Honorable Court that the Hearing of the above entitled case and the case of George E. Vandenburgh vs. Concrete Steel Company, No. 238, on the Docket for the October Term, 1922, be held the same day, said cases being upon the same patent involving substantially similar infringements and patented art."

and requesting Counsel for Truscon Steel Co. to join in motion "and forward to my Associate, Mr. E. C. Brown, 734 8th St., N. W., Washington, D. C., who will present it to the Supreme Court."

The undersigned has complied with the request.

W. F. GUTHRIE,
Counsel for Truscon Steel Co.

MEMORANDUM IN SUPPORT OF MOTION

Both above cases are before this Court upon petition for certiorari, granted on account of diversity of decisions in different circuits.

The Court of Appeals of the Second Circuit held the patent sued on in each case valid and infringed, and the Court of Appeals of the Sixth Circuit held it invalid.

The Government of the United States (we are informed) joined in the petition for certiorari in number 238 because of the pendency of a suit for $500,000 against the United States for infringement of the same patent now pending and undisposed of.

Petition for certiorari in case number 273 was not granted upon the application of but against Truscon Steel Company.

The questions arising upon the record in each case are identical except:

(a) The alleged infringing structures are different; but the difference is very slight, being only in the form and location of the cuts or notches in a longitudinal bar, in which are held, for proper spacing, the convolutions of a helical coil, retained in the notches by hammering down the edges of the notches. This difference could be fully noted by the Court upon a moment's inspection of the respective exhibits;

(b) The defendant below in case number 273 offered in evidence, in addition to the prior art patents offered in number 238, additional prior art patents believed to be pertinent to the defense of non-invention (which was not discussed at all in the opinion in the Second Circuit) and offered an expert witness to disclose the technical factors of stress, etc. involved in the practice of the art to which the patent would be applied, but no expert testimony attempting to construe

or explain patents or otherwise express an opinion upon the proper construction or validity thereof. Plaintiff sought to rebutt this testimony.

It is believed that this Court should have opportunity to consider all questions that respective counsel may believe to be presented by these substantially identical records at one time, and thereby not only have the benefit of possibly different theories of presentation but avoid possibility of being subsequently asked in case 273 to consider new questions upon the same record, or to reconsider questions already presented upon any claim that matters affecting same were not fully presented in the first hearing.

Respondent-Appellee is willing to accept such reasonable abbreviation of the usual time for oral argument as the Court may deem proper under the circumstances.

W. F. GUTHRIE,
Counsel for Truscon Steel Co.,
c-o Truscon Steel Co., Youngstown, Ohio.

IN THE

Supreme Court of the United States

No. 764, October Term, 1921.

NOW

No. 273, October Term, 1922.

George E. Vandenburgh,
Petitioner-Complainant,

vs.

Truscon Steel Company, a Corporation,
Respondent-Defendant.

BRIEF OF RESPONDENT-DEFENDANT.

W. F. Guthrie,
Of Counsel for Defendant,
Youngston, Ohio.

Press of Byron S. Adams, Washington, D. C.

IN THE

Supreme Court of the United States

No. 764, October Term, 1921,

NOW

No. 273, October Term, 1922.

George E. Vandenburgh,
Petitioner-Complainant,

vs.

Truscon Steel Company, a Corporation,
Respondent-Defendant.

BRIEF OF RESPONDENT-DEFENDANT.

EXPLANATORY.

Although the imprint upon the back of the brief for petitioner-complainant shows that it was prepared for service during "October, 1922" (attorney for petitioner assuming that service, instead of filing, was required), nevertheless, the brief itself was filed in this Court and first came to the attention of respondent-defendant today, January 15, 1923. This was rather in line with proceedings in the court below, where the record was held back for months, the case disposed of at its setting by waiver of time by the respondent below, with reply brief filed just as the case was called for hearing.

This situation prevents submission without delay except by respondent-defendant using its brief as appellee in the Court of Appeals of the Sixth Circuit. The paging of the record in this court corresponds with the paging of the record in the Court of Appeals, so that references in the brief below to record paging are still available without change.

We will immediately follow by the insertion of the brief below and follow the conclusion of that brief with such few additions as the brief of petitioner in this court suggests as possibly, but only possibly, necessary.